



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
GRANT II, J

ART UNIT
2724

PAPER NUMBER

DATE MAILED: 10/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/218,335

Applicant(s)

Omi

Examiner

Jerome Grant

Group Art Unit

2724

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 22-47 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22-47 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☒ received in Application No. (Series Code/Serial Number) 09/215,608
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Reissue Application: 09/218,335
Art Unit: 2724

1. Applicant is required to surrender the "*defective patent*" as required by 35 U.S.C. 251 (or) submit an affidavit/declaration averring that the original patent is lost or misplaced.
2. Applicant is advised that new matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. 251.
3. Claims 12-47 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):
The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In a recent court decision, *In re Clement* (CAFC), 45 USPQ 2d 1161, the court used a three part test to determine the relevance of a prior art rejection in determining when claims in a reissue application may be properly broadened. See *Mentor Corp. V. Coloplast, Inc* 998 F.2d 992, 27 USPQ 2d 1521, (Fed. Cir. 1993) & *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984).

From the courts reasoning, the following principles were applied:

1) if the reissue claim is as broad as or broader than the canceled or amended claim, in all aspects, the recapture rule bars the claim; 2) if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible; 3) if the reissue claim is broader in some aspects, but narrower in other, then: a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, by narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; b) if the reissue claim is narrowing in an aspect germane to prior art rejection, and boarder in an aspect unrelated to the rejection, the recapture rule doe not bar the claim, but other rejections are possible.

In the instant case, independent claims 12 and 30 recite an image forming system, comprising:
a printer module;
a scanner module.

In claims 12-29, however, the respective modules include limitations which narrow the scope thereof namely "... a first frame...." and "... a second frame different from the first frame..." and were not related to the rejections in the original case made by the examiner in the March 18, 1996 office action.

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Art Unit: 2724

In claims 30-47, however, "...means for supporting elements of the printer module..." and "...means for supporting elements of the scanner module..." narrow the claims in scope and were not related to the rejections in the original case made by the examiner in the March 18, 1996 office action.

In distinction to claims 12 and 30 of the Reissue application, however, claim 1 of the original patent recites:
a scanner module;
a printer module;
and a system control module.

In comparison, claim 12 of the Reissue application broadens the scope but is narrower in aspect with the 1st and 2nd frame, than claim 1 (as amended March 18, 1996) of the original patent.

In comparison, claim 30 of the Reissue application is broader in scope but narrower in aspect of --means for supporting elements of the scanner/printer module-- than claim 1 of the original patent.

In conclusion, claims 12-47 are rejected under 35 U.S.C. Sect 251 para. 1 for lack of basis for Reissue application since said claims re barred in view of the June 17, 1996 amendment to claim 1 of the original patent, in accordance with the "*recapture rule*". See *Clements*, Id.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is (703) 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on (703) 308-7254. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

J. Grant II
Sept. 27, 1999